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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Webb & Associates, Inc.

Serial No. 75868810

Andrew W. Ransom of Malloy & Malloy, P.A. for Webb & Associates, Inc.

Brian D. Brown, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Holtzman, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 13, 1999, Webb & Associates, Inc.
(applicant) applied to register the term NEED SPACE (typed)
on the Principal Register for services ultimately
identified as:

Referrals for general building contractors in Class
35.

Real estate agency services, namely, real estate
brokerage, leasing, and agency representation for
commercial renters obtaining utility hook-up services
in Class 36.

Real estate site selection; real estate development;
general contracting services in the nature of
electrical and plumbing contracting in Class 37.

Architectural design services in Class 42.

The application (Serial No. 75868810) was based on applicant's assertion of a bona fide intention to use the mark in commerce. Applicant's mark was published for opposition on August 14, 2001. A Notice of Allowance was issued on November 6, 2001. On May 6, 2002, applicant filed a Statement of Use alleging that it had used the mark on the goods anywhere and in commerce at least as early as July 1998. Some of the specimens submitted with the Statement of Use are set out below.





The examining attorney¹ then refused to register applicant's term on the basis that it fails to function as a mark under the provisions of Sections 1, 2, 3, and 45 of the Trademark Act. 15 U.S.C. §§ 1051, 1052, 1053, and 1127. Applicant responded to the refusal by, inter alia, submitting another example of applicant's use of its mark, a portion of which is displayed below.

¹ The present examining attorney was not the original examining attorney in this case.



After the examining attorney made the refusal final, applicant submitted a request for reconsideration. The request contained additional examples of use, one of which is set out below.



The examining attorney denied the request for reconsideration and he provided examples of other parties' use of the term "need space" in association with real estate-related services. Two examples are set out below.





After the request for reconsideration was denied, applicant filed a notice of appeal.²

We begin our discussion by first addressing some procedural issues. Applicant's request for reconsideration (pp. 1-2, n.1) contained the following statement, which is repeated in its appeal brief (p. 12, n.2).

The Examiner's argument and objection has not been raised pursuant to Section 2(e) on the separate grounds that the mark is merely descriptive. However, to the extent it may be determined or later found that such an objection was intended to be or was lodged under section 2(e), then leave is requested to so respond. Moreover, in the event that such an argument is asserted, while Applicant believes the mark is not descriptive and would so argue, in the alternative, it is respectively suggested that Registration is proper pursuant to Section 2(f), on the ground that the mark has acquired distinctiveness through its use, as supported by the attached Declaration. Accordingly, pursuant to TMEP § 1212.02(c), Applicant hereby claims and seeks registration, in the alternative, on the basis of acquired distinctiveness pursuant to § 2(f).

Finally, again, in the alternative, pursuant to TMEP § 1212.02(c), should registration on the Principal Register be refused, Applicant requests registration on the Supplemental Register.

² An oral hearing was held on December 7, 2004.

At oral argument, it was clear that there was no refusal based on the ground that the mark was merely descriptive and applicant clarified that it was not interested in seeking registration on the Supplemental Register. We add that, to the extent that applicant is attempting to overcome the examining attorney's refusal by seeking registration under the provision of Section 2(f), such an action is unnecessary because the question here is not descriptiveness but whether applicant's term functions as a mark. However, applicant's evidence will be considered in determining whether applicant's term does function as a mark. Id.

Now we address the central issue of this appeal, which is whether applicant's term NEED SPACE functions as a mark for applicant's identified services. "The question whether the subject matter of an application for registration functions as a mark is determined by examining the specimens along with any other relevant material submitted by applicant during prosecution of the application." In re The Signal Companies, Inc., 228 USPQ 956, 957 (TTAB 1986).³

An important function of specimens in a trademark application is, manifestly, to enable the PTO to

³ In view of the criticality of the specimens and the fact that applicant filed an intent-to-use application, a refusal on the ground that applicant's term does not function as a mark would ordinarily not have been appropriate until the specimens were submitted.

verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a *trademark* with respect to the goods named in the application.

In re Bose Corp., 546 F.2d 893, 192 USPQ 213, 216 (CCPA 1976) (emphasis in original, footnote omitted).

"The Trademark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration. Words are not registrable *merely* because they do not happen to be descriptive of the goods or services with which they are associated." In re Standard Oil Co., 275 F.2d 945, 125 USPQ 227, 229 (CCPA 1960) (emphasis in original). "[N]ot every word or combination of words which appears on an entity's goods functions as a trademark." In re Volvo Cars of North America Inc., 46 USPQ2d 1455, 1459 (TTAB 1998).

Viewing applicant's mark as used on the specimens and other evidence of record, we cannot conclude that applicant's term functions as a mark. First, the term as used on the specimens set out earlier appears merely informational. The first specimen is a sign with the term NEED SPACE followed by a list of available space (3,600,

7,200, 10,000, etc. sq. ft. of office/warehouse space) and a telephone number and the phrase "for sales or leasing information" with applicant's corporate name. This sign merely informs people who need office or warehouse space that space is available in the specified square footage from applicant.

Applicant's second specimen contains the words "Need Space" followed by a telephone number on the same line. The next lines contain the term "commercial real estate services" and applicant's corporate name. Again, this specimen merely informs people who need commercial real estate space that applicant can assist customers in meeting their space needs. These specimens as well as the other literature display the mark in simple style that would not provide any basis for prospective purchasers to conclude that the term is a trademark. Nor is there any evidence that applicant's term is in fact recognized by others as a trademark.

Second, the examining attorney has included evidence that others in the area of real estate-related services use the term "Need Space." These uses include the following:

Need Space?
Hot New Properties

Are you looking for office space?

Do you need to buy or lease office, retail, or industrial space?

Starboard Commercial, www.starboardnet.com.⁴

Need Space Immediately? Check our In-House Listings. We may be able to locate vacant space which may be furnished...

CommercialBrokers.com.

Welcome to the Caldwell Banker Tsunis Rosner Website... Short on time. Click here to tell us what you are looking for: Need Space? Or call.

www.cbcli.com.

Brockton - 6 Bedroom - 2 Bath - Need Space? We got space.

www.bostonapartments.com.

Need space? Located in Carlisle township on nearly ½ acre lot.

www.realtyone.com.

Need Space? This old house is full of character and many rooms.

www.youronlineagents.com.

What a magnificent view - one of the highest points on lower Michigan. You need space? This 5 bd 2.5 bath has SPACE!

ERA.com.

The evidence indicates that the phrase "Need Space" is used with real estate-related services to indicate that the business can assist prospective customers fulfill their need for space by helping them build, find, select, or design the needed space.⁵

⁴ We note that the web addresses are often found in small print on the otherwise blank page preceding or following the web page.

⁵ The examining attorney also made of record definitions of "need" ("something required or wanted") and "space" ("a blank or empty area" and "an area provided for a particular purpose"). Denial of Request for Reconsideration at 2.

A term must do more than appear on a specimen in order to function as a trademark. See, e.g., Volvo Cars, 46 USPQ2d at 1460 (Primary significance of DRIVE SAFELY "likely to be perceived by purchasers and prospective purchasers is merely that of an everyday, commonplace safety admonition"); Wakefern Food, 222 USPQ at 78 (WHY PAY MORE is a "relatively common merchandising slogan [that] does not act or function as a mark"); and In re Manco Inc., 24 USPQ2d 1062, 1066 (TTAB 1992) ("`THINK GREEN,' irrespective of whether it appears along with a background design, would be perceived by applicant's customers and potential purchasers as merely an informational slogan devoid of trademark significance").

Applicant argues (Brief at 6) that "the phrase 'NEED SPACE' reflects a double entendre, functioning both as statement, and also having a whimsical meaning, namely identifying an imaginative actual location, as might be used in the phrase 'come to the 'NEED SPACE.'" Applicant has offered no evidence to support this argument and we are skeptical that any significant number of prospective customers upon seeing the words "NEED SPACE" on a sign followed by a listing of square footage, e.g., "3,600 sq. ft. +/- Office/Warehouse," would also understand the words to be a reference to a whimsical place.

Applicant [Brief at 16] maintains that "not a single one of [the examining attorney's attachments] uses Applicant's applied for mark, 'NEED SPACE.'" Applicant is apparently basing this argument on the fact that the examining attorney's evidence shows use of the words with a question mark. We do not see the absence of a question mark as particularly significant. Applicant itself sometimes uses the term with a question mark (See third and fourth examples of applicant's use set out previously) and sometimes without one (first and second examples). Applicant's "Need Space" signs and advertising with or without a punctuation mark convey the same message, i.e., that applicant is available to fulfill an entity's real estate needs.

We also add that the fact that the State of Florida has issued a registration to applicant for the subject term does not mean that applicant's term meets the Lanham Act's requirements for registration under Federal law. Furthermore, we note that while in some of applicant's literature it uses the term NEED SPACE with a TM symbol, this does not make unregistrable matter into a trademark. In re Remington Products Inc., 3 USPQ2d 1714, 1715 (TTAB 1987). See also Volvo Cars, 46 USPQ2d at 1461. Finally, applicant alleges that it has used the mark for a long

time. However, even if five years use and serving "over 71 residential and commercial customers"⁶ were to be considered long and extensive use, "long use of a slogan which is not a trademark and would not be so perceived does not, of course, transform the slogan into a trademark." In re Tilcon Warren, Inc., 221 USPQ 86, 88 (TTAB 1984).

Decision: The refusal to register the applied-for term on the ground that it does not function as a mark is affirmed.

⁶ Webb declaration, ¶ 10.